

BUCKET NO.: TJU-2563

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

Croce et al.

Serial No.: 09/855,294

Filing Date: May 15, 2001

Confirmation No.: 1905

Group Art Unit: 1645

Examiner: P. Duffy

DEC 06 2002

TECH CENTER 1600/2900

For: CRYSTAL STRUCTURE OF WORM NITFHIT REVEALS THAT A NIT  
TETRAMER BINDS TWO FHIT DIMERS

EXPRESS MAIL LABEL NO: EV160978352US  
DATE OF DEPOSIT: December 3, 2002

Assistant Commissioner for Patents  
Washington DC 20231

Dear Sir:

**REPLY UNDER 37 C.F.R. § 1.143 TO  
OFFICE ACTION DATED JUNE 5, 2002**

In response to the Office Action dated June 5, 2002, reconsideration of the requirement for restriction in view of the following remarks is requested respectfully.

Claims 1-40 are pending in the present application. A restriction has been required as to one of twenty-three groups of inventions, characterized as Groups I-XXIII. Applicants respectfully traverse the restriction requirement.

It is well settled that for an application to be properly restricted, there must be a serious burden on the Examiner. *See* MPEP § 803. Indeed, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on

the merits, even though it includes claims to independent or distinct inventions. Moreover, the Commissioner of Patents has decided *sua sponte* to partially waive the requirements of 37 C.F.R. § 1.141 *et seq.* with respect to polynucleotide sequences to permit a reasonable number of independent or distinct nucleotide sequences, normally ten sequences, to be examined in a single application. *See* MPEP § 803.04. Sequences that are patentably indistinct from the selected independent or distinct sequences will be examined in addition thereto. *Id.* In view of this position taken by the PTO, but without commenting on whether the various Groups are distinct from each other, Applicants respectfully submit that it would cause no serious burden to the Examiner to search more than one of the Groups identified by the Examiner.

Applicants respectfully submit that examination of the claims of Groups I, IV and XI, all drawn to polynucleotides encoding Nit2 proteins, would not impose a serious burden on the Examiner. A reasonable search for polynucleotides encoding Nit2 proteins would lead to disclosures, to the extent that any exist, of Nit2 sequences derived from human, mouse, frog, and other species of origin contained in the art. Additionally, the claims of Groups I, IV and XI all fall within the same class and subclass (i.e., class 536, subclass 23.1). A search in the same class and subclass could easily be conducted without undue burden. Applicants respectfully propose that, at a minimum, the claims of Groups I, IV and XI should be rejoined, since the examination of Groups I, IV and XI would clearly not impose a serious burden on the Examiner. Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

**Provisional Election Under 37 C.F.R. § 1.143**

Nonetheless, to be fully responsive, in accordance with 37 C.F.R. § 1.143, Applicants


hereby provisionally elect for prosecution the subject matter of Group I (Claims 1-3), which is drawn to isolated nucleic acids encoding human Nit2 proteins. Applicants hereby affirm the right to file one or more divisional applications directed to any of the non-elected subject matter.

**Conclusion**

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, reconsideration and withdrawal of the restriction requirement and an early and favorable Action are requested respectfully.

Respectfully submitted,

Date: *December 3, 2002*

  
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